

REMARKS

This Response is submitted in response to the Office Action dated November 4, 2003. Claims 1 to 13, 15 to 34 and 36 to 40 were previously pending in this application. Claims 14 and 35 were previously canceled without prejudice or disclaimer. Claims 1, 10, 20, 27, 29 and 36 are being amended herein. No new matter has been added via these amendments. A two month Petition for Extension of Time to Respond to the Office Action and a Supplemental Information Disclosure Statement are submitted herewith. Checks in the amount of \$180.00 and \$410.00 are submitted herewith to cover the cost of the Extension and the Supplemental Information Disclosure Statement, respectively. Please charge Deposit Account No. 02-1818 for any insufficiency of payment.

In the Office Action, the Patent Office approved the proposed drawing corrections submitted on July 31, 2002. A set of formal drawings having the approved drawing corrections is being submitted herewith. Claim 1 was rejected under 35 U.S.C. § 112 because the term "X" was not defined sufficiently to claim the invention distinctly. The amendment to Claim 1 herein has addressed the section 112 rejection.

Claims 1, 2, 5, 8 to 11, 20, 23, 27 to 30 and 36 to 38 were rejected under 35 U.S.C. § 103(a) as being obvious in view of: (i) U.S. Patent No. 6,322,309 to Thomas et al. ("*Thomas*"); (ii) Tic-Tac-Dough, <www.angelfire.com/~wrestling3/jay_anton/tictackpages/tictacdough.html> ("*Tic-Tac-Dough*"); and (iii) U.S. Patent No. 6,174,235 to Walker et al. ("*Walker*").

Claims 3, 4, 12, 13, 21, 22, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Thomas*, *Tic-Tac-Dough*, *Walker* and U.S. Patent No. 6,231,442 to Mayeroff ("*Mayeroff*").

Claims 6, 7, 24 and 25 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Thomas*, *Tic-Tac-Dough*, *Walker* and U.S. Patent No. 5,647,798 to Faciglia ("*Faciglia*").

Claims 16, 17, 18, 19 and 26 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Thomas*, *Tic-Tac-Dough*, *Walker* and in further view of U.S. Patent No. 5,882,259 to Holmes ("*Holmes*").

Claims 33, 34, 39 and 40 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Thomas*, *Tic-Tac-Dough*, *Walker* and in further view of U.S. Patent No. 6,001,016 to Walker ("*Walker '016*").

Regarding the obviousness rejection of Claim 1, the primary references used by the Patent Office were *Thomas* and *Tic-Tac-Dough*. Both of these references were used to show games having selections that yield credits as well as award symbols. The award symbols accumulate towards an award. The pertinent portion of *Thomas* begins at approximately column 11, line 37. *Thomas* discusses supplemental coins or credits that are awarded upon completion of a group, such as a color group. *Thomas* gives the example of providing credits for obtaining Boardwalk and Park Place. As seen in Figs. 8 and 9 discussed in connection with the Monopoly™ embodiment in column 11 of *Thomas*, the game of *Thomas* provides thirty selections from which the player can choose. Thus, for example, the supplemental award for Boardwalk and Park Place requires the player to select two of thirty possible selections.

The pertinent portion of *Tic-Tac-Dough* is disclosed at the end of the printout provided by the Patent Office, which discusses two versions of a bonus round, namely, the "CBS Run" and the "Syndicated .Run". Both embodiments disclose a Tic-Tac-Toe board providing nine selections to the player. In the CBS Run bonus round, a single "*Tic-Tac-Dough*" symbol was placed behind one of the selections. A dragon was also placed behind one of the selections. If the player selected the *Tic-Tac-Dough* selection before selecting the dragon, the player won a bonus amount. In the CBS Run version the player therefore had to accumulate one award symbol out of the nine to win the bonus.

In the Syndicated Run version, the player had to accumulate separate "Tic" and "Tac" symbols to win a bonus value. In the Syndicated Run version, the player had to accumulate two out of nine symbols to achieve the bonus award.

The *Walker* reference as stated at page 6 of the Office Action teaches, in general, providing different payouts for achieving different combinations of symbols and does not overcome the deficiencies of *Thomas* and *Tic-Tac-Dough*. Applicants respectfully submit that the combination of those cited references does not teach the claims as amended. In particular, and as discussed in the two telephone interviews with

the Examiner, the present invention discloses a number of embodiments. In one of the embodiments, the player has a plurality of selections. The player selects from a group of symbols wherein certain symbols are award symbols. Each of the player's selections in one embodiment must result in the selection of an award symbol for the player to win the large jackpot award. In another embodiment, the gaming device provides the player one opportunity to select a symbol that is not an award symbol. All other selections must result in award symbols for the player to win the large jackpot award. The combination of *Thomas*, *Tic-Tac-Dough*, and *Walker* does not teach or suggest this game. In *Thomas*, the player has a multitude of opportunities to select symbols other than award symbols and still win one of the color scheme bonuses. In *Tic-Tac-Dough*, the player can select up to eight selections to achieve either one symbol or two symbols depending on which bonus round is played. The difference between the present invention and the combination of *Thomas* and *Tic-Tac-Dough* has been incorporated into the claims via amendment.

In light of the foregoing, Claim 1 as amended is directed to a gaming device having a bonus scheme. The gaming device includes a plurality of selections. A plurality of credit symbols are associated with a first plurality of the selections. A plurality of award symbols are associated with a second plurality of the selections. A winning combination of at least two award symbols and a jackpot award is associated with the winning combination of symbols. A display device is provided that displays the selections, credit symbols and award symbols to a player. The display device communicates with a processor. The processor provides a number of credits to the player when the player chooses the first selections (those associated with the credit symbols). The processor accumulates the award symbols when the player chooses the second selections (those associated with the award symbols). The processor provides the player the jackpot award when the accumulated award symbols reach the winning combination. All or all but one of a provided number of player picks of the selections must result in award symbols to achieve the winning combination. The number of picks provided to the player is at least two.

As discussed above, the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* does not teach or suggest the features of amended Claim 1. Namely, those references

do not provide the player more opportunities to select non-award symbols and still win the award. Applicants respectfully submit therefore that amended Claim 1 and Claims 2 to 9 that depend therefrom are each patentably distinct over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* and are in condition for allowance.

Claim 10 as amended is directed to a method of operating a bonus round of a gaming device. The method includes the following steps: (a) triggering the bonus round; (b) displaying a plurality of selections to a player; (c) picking one of the selections; (d) displaying a symbol associated with the picked selection; (e) accumulating the symbol if the symbol associated with the picked selection is an award symbol; (f) providing the player an award if the symbol associated with the picked selection is a credit symbol; (g) repeating steps (c) through (f) until at least two selections are picked; and (h) providing the player a jackpot award if the accumulated award symbols reach a predetermined number of at least two award symbols, wherein all or all but one of the number of pick selections must result in award symbols to achieve the jackpot award.

As discussed above, the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* does not teach or suggest the combination of amended Claim 10. In particular, none of the references suggests providing that all or all but one of the player's selections has to result in an award symbol to receive a jackpot award. In both *Thomas* and *Tic-Tac-Dough* the player may select multiple selections that are not award symbols and still win the jackpot award. *Walker* does nothing to remedy the deficiencies of *Thomas* and *Tic-Tac-Dough*. Applicants respectfully submit that amended Claim 10 and Claims 11 to 19 that depend therefrom are patentably distinguished over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* and are in condition for allowance.

Amended Claim 20 is directed to a gaming device having a game. The gaming device includes a plurality of selections. A plurality of credit symbols are associated with a first plurality of the selections. A plurality of award symbols are associated with a second plurality of the selections. A display device displays those selections, credit symbols and award symbol to a player. The display device communicates with a processor. The processor provides the player with a number of picks of the selections. The processor provides the player with an amount of credits for each pick of one of the

first selections. The processor provides the player with a jackpot award if the player selects a predetermined number of the second selections (associated with award symbols) within the player's number of picks of the selections. The predetermined number of the second selections is at least two and is the same as or one less than the number of picks.

For the reasons discussed above, the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* does not teach or suggest amended Claim 20. In particular, the combination of references does not teach or suggest the number of selections required for a jackpot award being the same as or one less than a number of picks provided in order to obtain the jackpot award. Applicants respectfully submit that amended Claim 20 and Claims 21 to 26 that depend therefrom are each patentably distinct over the combination of *Thomas*, *Walker* and *Tic-Tac-Dough* and are in condition for allowance.

Claim 27 as amended is directed to a gaming device having a game. The gaming device includes a plurality of selections. A plurality of credit symbols are associated with a first plurality of the selections. A plurality of award symbols are associated with a second plurality of the selections. A display device displays the selections, the credit symbols and award symbols to a player. The display device communicates with a processor. The processor: (i) provides the player with at least two picks of the selections; (ii) provides the player with an amount of credits for each pick of one of the first selections; (iii) accumulates the award symbols for each pick of one of the second selections; and (iv) provides the player an award based on the number of accumulated award symbols associated with the selections picked by the player. The number of accumulated awards symbols required for the award is at least two, and the predetermined number of picks is not more than one plus the number of the award symbols.

The combination of *Thomas*, *Tic-Tac-Dough* and *Walker* does not teach or suggest the elements of Claim 27 as amended. In particular, amended Claim 27 specifies that at least two award symbols have to be accumulated to win the award and the player has a number of picks that is not more than one plus the number of award symbols. As discussed above, *Thomas* and *Tic-Tac-Dough* provide a substantially greater number of picks than is necessary to obtain the jackpot awards disclosed by

those references. Applicants respectfully submit that amended Claim 27 and Claim 28 that depends therefrom are patentably distinguished over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* and are in condition for allowance.

Claim 29 as amended is also patentably distinguished over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker*. Claim 29 is directed to a method of operating a gaming device. The method includes the steps of: (i) displaying a plurality of selections to a player; (ii) enabling the player to make a predetermined number of at least two picks of the selections; (iii) displaying a symbol associated with each picked selection; (iv) accumulating the symbol if the symbol is an award symbol, wherein a number of possible selectable award symbols is one less or equal to the predetermined number of picks; (v) providing the player at least one credit if the symbol is a credit symbol; and (vi) providing the player an additional award based on an accumulated number of award symbols.

The combination of *Thomas*, *Tic-Tac-Dough* and *Walker* does not teach or suggest the elements recited in amended Claim 29. In particular, none of those references teaches or suggests providing a number of possible selectable award symbols that is one less or equal to a predetermined number of picks. For example, *Thomas* provides thirty picks and bases the color scheme awards on an accumulation of a number of matched selections in the range of two or three colors. Further, in *Tic-Tac-Dough* the bonus rounds provide the player up to eight chances to select a bonus combination of at most two selections in one case and only a single selection in the other disclosed bonus round. Accordingly, the combination of those references does not teach the elements of amended Claim 29. As stated above, *Walker* does not remedy the deficiencies of *Thomas* and *Tic-Tac-Dough*. Applicants therefore respectfully submit that Claim 29 as amended and Claims 30 to 35 that depend therefrom are each patentably distinguished over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker*.

Amended Claim 36 is also patentable over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker*. Amended Claim 36 is directed to a gaming device. The gaming device includes a plurality of selections. A plurality of credit symbols are associated with a first plurality of the selections. A plurality of award symbols are associated with a

second plurality of the selections. There is also a winning combination of the award symbols. A processor provides at least two picks of the selections, wherein at least one credit is provided to a player for each picked first selection (associated with credit symbols). A jackpot award is provided to the player only if, for each of the provided number of picks, the player picks second selections (associated with award symbols) that form the winning combination of award symbols.

The combination of *Thomas*, *Tic-Tac-Dough* and *Walker* does not teach the elements of amended Claim 36. In particular, both *Thomas* and *Tic-Tac-Dough* allow the player to select at least one symbol that is not one of the award symbols and still allow the player to achieve the additional or jackpot award. Applicants therefore respectfully submit that Claim 36 as amended and Claim 37 that depends therefrom are each patentably distinguished over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker* and are in condition for allowance.

Regarding the rejection of Claim 38 in view of *Thomas*, *Tic-Tac-Dough* and *Walker*, Applicants respectfully traverse that rejection. Reiterating the arguments made in previous response of July 31, 2002, Applicants do not believe that there is any teaching in *Thomas*, *Tic-Tac-Dough* and *Walker* that suggests the desirability of structuring the odds of a game to be low enough so that a jackpot award can be approximately \$1,000,000. While large progressive payouts are known, Claim 38 is distinguished from such progressive payouts because Claim 38 is provided in a bonus game that is based on a plurality of selections. Moreover, Claim 38 includes jackpot award symbols that must be accumulated to achieve the jackpot award. There is no teaching or suggestion in the art cited of a single, i.e., nonprogressive game, which provides a number of selections to the player, and requires the player to pick from those selections a required number of jackpot symbols to achieve a large payout of approximately \$1,000,000. Applicants therefore respectfully submit that Claim 38 as originally added and Claims 39 and 40 that depend therefrom are each patentably distinguished over the combination of *Thomas*, *Tic-Tac-Dough* and *Walker*.

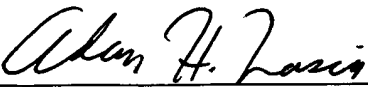
Regarding the remaining rejections, because amended Claim 1 is patentable over *Thomas*, *Tic-Tac-Dough* and *Walker*, the obviousness rejection of Claims 3 and 4 in further view of *Mayeroff* and the obviousness rejection of Claims 6 and 7 in further

view of *Faciglia* are rendered moot. Further, because Claim 10 is patentable over *Thomas, Tic-Tac-Dough* and *Walker*, the obviousness rejection of Claims 12 and 13 in further view of *Mayeroff* and the obviousness rejection of Claims 16 to 19 in further view of *Holmes* are rendered moot. Yet further, because amended Claim 20 is patentably distinguished over *Thomas, Tic-Tac-Dough* and *Walker*, the obviousness rejection of Claims 21 and 22 in further view of *Mayeroff* the obviousness rejection of Claims 24 and 25 in further view of *Faciglia* and of Claim 26 in further view of *Holmes* are rendered moot. Still further, because amended Claim 29 is patentably distinguished over *Thomas, Tic-Tac-Dough* and *Walker*, the obviousness rejection of Claims 31 and 32 in further view of *Mayeroff* and obviousness rejection of Claims 33 and 34 in view of *Walker '016* are rendered moot. Moreover, because Claim 38 as originally added is patentably distinguished over *Thomas, Tic-Tac-Dough* and *Walker*, the obviousness rejection of Claims 39 and 40 in further view of *Walker '016* is also rendered moot.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding the above amendment, Applicants respectfully requests that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss the amendment.

Attached hereto is a marked-up version of the amendments made to the claims. The attached page is captioned "**Version with markings to show changes made.**"

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claim 1 has been amended as follows:

1. (Three Times Amended) A gaming device having a bonus scheme comprising:
 - a plurality of selections;
 - a plurality of credit symbols associated with a first plurality of said selections;
 - a plurality of award symbols associated with a second plurality of said selections;
 - a winning combination of at least two award symbols and a jackpot award associated with said winning combination of award symbols, ~~the winning combination of award symbols requiring X number of said award symbols;~~
 - ~~at least one award less than the jackpot award associated with a combination of award symbols different from the winning combination, the different combination requiring a plurality of but less than X number of award symbols;~~
 - a display device adapted to display the selections, credit symbols and award symbols to a player; and
 - a processor which communicates with the display device, provides a number of credits to the player when the player chooses ~~each of the~~ first selections ~~having an associated credit symbol,~~ accumulates the award symbols when the player chooses ~~each selection~~ the second selections ~~having an associated award symbol, and~~ provides the player the jackpot award when the accumulated award symbols reach said winning combination of ~~X number of award symbols and provides the award if the accumulated award symbols reach the different combination of award symbols having less than X number of award symbols,~~ wherein all or all but one of a provided number of player picks of the selections must result in award symbols to achieve the winning combination, and wherein the number of picks is at least two.

Claims 10 has been amended as follows:

10. (Three Times Amended) A method of operating a bonus round of a gaming device, said method comprising the steps of:

- (a) triggering said bonus round;
- (b) displaying a plurality of selections to a player;
- (c) picking one of the selections;
- (d) displaying a symbol associated with the picked selection;
- (e) accumulating the symbol if the symbol associated with the picked selection is an award symbol, ~~wherein at least one award is associated with one of the award symbols;~~
- (f) providing the player an award if the symbol associated with the picked selection is a credit symbol;
- (g) repeating steps (c) through (f) until ~~a number of~~ at least two selections are picked; and
- (h) providing the player a jackpot award if the accumulated award symbols reach a predetermined number of at least two award symbols; ~~and~~
- ~~(i) providing the player an award less than the jackpot award if there is at least two but less than the predetermined number of accumulated award symbols.~~ , wherein all or all but one of the number of picked selections must result in award symbols to achieve the jackpot award.

Claim 20 has been amended as follows:

20. (Twice Amended) A gaming device having a game comprising:

- a plurality of selections;
- a plurality of credit symbols associated with a first plurality of said selections;
- a plurality of award symbols associated with a second plurality of said selections;
- a display device adapted to display the selections, credit symbols and award symbols to a player; and

a processor in communication with the display device, said processor providing the player with a number of picks of the selections, providing the player with an amount of credits for each pick of one of the first selections ~~having an associated credit symbol~~, ~~providing the player with an amount of credits for at least two picks of the selections having an associated award symbol~~, and providing the player a jackpot award if the player selects a predetermined number of the second selections ~~having associated award symbols~~ with the player's number of picks of the selections, the predetermined number of the second selections being at least two and the same or one less than the number of picks.

Claim 27 has been amended as follows:

27. (Twice Amended) A gaming device having a game comprising:

- a plurality of selections;
- a plurality of credit symbols associated with a first plurality of said selections;
- a plurality of award symbols associated with a second plurality of said selections;
- a display device adapted to display the selections, credit symbols and award symbols to a player; and

- a processor in communication with the display device, said processor providing the player with ~~a number of~~ at least two picks of the selections, providing the player with an amount of credits for each pick of one of the first selections ~~having an associated credit symbol~~, accumulating the award symbols for each pick of one of the second selections ~~having an associated award symbol~~, and providing the player an award that ~~varies~~ based on the number of accumulated award symbols associated with the selections picked by the player, ~~the number being at least two, wherein said award non-linearly increases as the number of accumulated award symbols increases~~ the number of accumulated award symbols required for the award being at least two and the predetermined number of picks being not more than one plus the number of award symbols.

Claim 29 has been amended as follows:

29. (Amended) A method of operating a game of a gaming device, said method comprising the steps of:

- (a) displaying a plurality of selections to a player;
- (b) enabling the player to make a predetermined number of at least two picks of said selections;
- (c) displaying a symbol associated with each picked selection;
- (d) accumulating the symbol if said symbol is an award symbol, wherein a number of possible selectable award symbols is one less or equal to the predetermined number of picks;
- (e) providing the player at least one credit if the symbol is a credit symbol; and
- (f) providing the player an additional award ~~that varies based on at least two~~ an accumulated number of award symbols, ~~wherein said additional award non-linearly increases as the number of accumulated award symbols increases.~~

Claim 36 has been amended as follows:

36. (Amended) A gaming device comprising:

- a plurality of selections;
- a plurality of credit symbols associated with a first plurality of said selections;
- a plurality of award symbols associated with a second plurality of said selections;
- a winning combination of award symbols;
- a processor providing ~~a number of~~ at least two picks of the selections;
- at least one credit provided to a player for each picked first selection ~~having an associated credit symbol~~; and
- a jackpot award provided to the player only if, for each of the provided number of picks, the player picks the second selections ~~having associated award symbols~~ which form the winning combination of award symbols.